

Summary of Invention

The present invention is generally directed to a system for providing remote access to a automated financial transaction machine. In accordance with one aspect of the invention, the system includes an automated financial transaction machine, and receiving means provided at the automated financial transaction machine for receiving data transmitted via electromagnetic waves. Although not necessary for the invention, in a preferred the automated financial transaction machine includes a card reader for receiving and reading magnetically encoded cards. In this embodiment, the receiving means is operatively and electrically connected to the magnetic card reader, so as to allow the system to operate either by access from a remote transmitter or by way of an inserted card. The system of the invention further includes a remote access unit having a memory configured to store user identification data and a low-power transmitter adapted to transmit the user identification data to the receiving means. The remote access unit is manually operated by a transmit button, which, when depressed, causes a controller to retrieve user identification data from the memory and transmit the user identification data from the low-power transmitter. In addition the user identification data, the transmitter also transmits synchronization bits and a function code that specifies a function that is to be performed.

Discussion

In connection with the preparation of this response, the undersigned noticed a typographical error in the specification. Specifically, the undersigned noticed that the word "text" was used on page

16, line 17, where the word "test" should have been used. The undersigned has corrected this error through the foregoing amendment to the specification. It is respectfully submitted that this amendment adds no new matter to the specification, as a person of ordinary skill in the art would have readily recognized the intended meaning of the word. In this regard, the sentence that immediately follows the corrected sentence refers to the "test" bits that are used if the function is a "test" sequence. In view of this sentence that immediately follows the sentence that originally included the term "text", a person of skill in the art would have recognized that the term "text" was merely a typographical error, and that the term should have been "test". Nevertheless, since "test" bits and a "test" sequence were discussed in the specification, as originally filed, the foregoing amendment adds no new matter to the disclosure, and therefore should be entered.

Claim Rejections under 35 U.S.C. § 112, first paragraph

The Office Action rejected claim 23 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection. The specification describes the claimed function code in terms of a function byte. More particularly, page 16, lines 15-19 provides:

Following the data bytes 94 is a function byte 96. This byte includes bits that identifies the transmitted function. For example, whether the function is an ATFM access, a *text** code, automobile lock, a distress call (in the embodiment discussed below), *etc.* It also includes test bits that are use if the function is a test sequence.

*Note: the term "text" is now "test" by virtue of the amendment made hereinabove to the specification.

Accordingly, the originally-filed specification provides adequate support (in fact, a virtually verbatim recitation) for the language of claim 23. Therefore, Applicant respectfully submits that this rejection should be removed.

Claim Rejections Under 35 U.S.C. § 112, second paragraph

The Office Action rejected claims 21-25 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this regard, the Office Action states that the phrases “the user-depressable transmit button” in line 8 of claim 21 and bridging lines 6 and 7 of claim 25 renders these claims indefinite. In response, Applicant has amended each of these claims herein to delete the term “transmit” from this phrase. Claim 1 does provide proper antecedent support for the phrase “user-depressable button”. Accordingly, Applicant respectfully submits that the rejection under 35 U.S.C. § 112, second paragraph has been properly addressed, and should now be removed.

Claim Rejections Under 35 U.S.C. § 103(a)

The Office Action rejected claims 21-23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Tait *et al.* in view of Waraksa *et al.* Applicant respectfully traverses this rejection on the following independent bases: (1) collectively, the combination fails to disclose every element of Applicant’s claimed invention; and (2) there is no proper suggestion or motivation to combine the particular elements alleged by the Office Actions to render the claimed invention unpatentable, and, as a matter of law, the two references fail to render obvious the presently claimed invention.

It is well established law that, when combining references to form a rejection under 35 U.S.C. § 103(a), the references must, collectively, disclose every element of the rejected claim(s). *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). With regard to independent claim 21, among other features and limitations, this claim specifically provides:

21. A remote access device for accessing a financial transaction machine comprising:

...
a memory configured to store ***user identification data, including track 1 and track 2 data;***

...
a controller configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, ***without any verification of user identification data***, the controller being configured to control the transmitter to ***transmit a plurality of synchronization bits, track one and track two data, and a function code that identifies a transmitted function.***

(Emphasis added).

Thus, claim 21 specifically defines the “user identification data” to include track one and track two data. The Office Action, in contrast, has applied Waraksa *et al.* as allegedly disclosing “a remote access device in which a transmitter transmits a plurality of synchronization bits, a function code ***and an identification code.***” (Office Action, page 4, lines 2-3). Among other differences, the identification code of Waraksa *et al.* is significantly different than that defined in claim 21. In this regard, the “identification code” of Waraksa *et al.* is simply a random binary value that is set to match a receiver, simply to eliminate (or significantly reduce) the activation of the keyless entry system of Waraksa *et al.* by another that is toting a similar transmitter. Thus, the identification code of the system of Waraksa *et al.* conveys no “user” information, much less any track one or track two data as specifically claimed in claim 21. Indeed, Waraksa specifically states (at the location cited by the Office Action):

In addition, it will be appreciated that the 20-bit IDENTIFICATION code provides in excess of one million different ID codes, thereby significantly reducing the probability that two beacons with the same ID code will be present in the same vicinity at the same time.

There is no disclosure or suggestion within Waraksa that the identification code convey or identify any user-specific or user-identifying information (much less any track one or track two data). Accordingly, and for this reason alone, the rejection under 35 U.S.C. § 103(a) should be removed, as collectively Tait *et al.* and Waraska *et al.* fail to disclose or suggest all elements of independent claim 21. For at least the same reason, the rejections to dependent claims 22-24 should be removed as well.

In addition to the foregoing distinction, and forming an independent basis for patentability, claim 21 specifically claims that the invention includes a controller that is “configured to control the transmitter to transmit the track one and track two data in direct response to a manual depression of the user-depressable button, without any verification of user identification data.” There is no comparable disclosure or teaching within Tait *et al.* or Waraksa *et al.* Specifically, the system of Tait *et al.* requires the user to key in a PIN number to verify her identity to the transmitter, as a matter of improved security. However, the present invention provides a more user friendly transmitter, which presumes security, and transmits track one and track two data “without any verification of user identification data.” Accordingly, Tait *et al.* fails to disclose this claimed limitation. Likewise, Waraksa *et al.* fails to disclose this limitation, as the system of Waraksa *et al.* does not communicate track one or track two data (or any personal identification data for that matter).

Accordingly, and for this separate and independent reason, the rejection under 35 U.S.C. § 103(a) should be removed, as collectively Tait *et al.* and Waraska *et al.* fail to disclose or suggest all

elements of independent claim 21. For at least the same reason, the rejections to dependent claims 22-24 should be removed as well.

The Office Action also rejected independent claim 25 for the same reasons as it rejected independent claim 21 (grouping this claim in with the same rejection). However, claim 25 sets forth different and additional elements, which require a separate analysis, and which further define it over the prior art. In this regard, and like claim 21, independent claim 25 defines:

25. A system for providing cardless access to a financial transaction machine comprising:

... a memory configured to store user identification data, including track 1 and track 2 data and a function code, ...and a controller configured to control the transmitter to transmit the track one and track two data and function code, in direct response to a manual depression of the user-depressable button, without any verification of user identification data...

Accordingly, Applicant respectfully submits that, based on these elements, independent claim 25 patently defines over the combination of Tait *et al.* and Waraksa *et al.* for at least the same reasons as set forth in connection with claim 21, above.

In addition, however, independent claim 25 further defines:

25. A system for providing cardless access to a financial transaction machine comprising:

a remote access device having a single user-depressable button,...
an automated financial transaction machine having a magnetic card reader and receiving means for receiving data transmitted from the remote access device via electromagnetic waves, the receiving means being operatively and electrically connected to the magnetic card reader; and
a network for communicating user identification data to a remote location.

(Emphasis added).

Neither the device disclosed in Tait *et al.* nor Waraksa *et al.* discloses “a single user-depressable transmit button”. In fact, the device of Tait *et al.* requires a keypad of addition buttons in order that the user can key in her PIN number, as required by that system. In contrast, the system of Waraksa *et al.* discloses a keyless entry device that requires no user activation. In this regard, Waraksa *et al.* characterizes its system as “passive,” which operates based upon motion detection and without affirmative user action. As long as the device is moving (e.g., as a person is walking), it transmits a continuous electromagnetic signal of low power. When the user walks within approximately three feet of the automobile, the receiver (in the automobile) then detects the low power transmitted signal, and responds accordingly (e.g., by unlocking the doors). What is significant, however, is that the system of Waraksa *et al.* requires no user-intervention, and therefore it lacks the “single user-depressable button” limitation, nor does it satisfy the limitation that the controller transmit the track one and track two data **“in direct response to a manual depression of the user-depressable button,”** of claim 25.

Accordingly, and for at least this additional reason, Applicant respectfully submits that the rejection to independent claim 25 be removed.

Further, claim 25 defines a remote access device having both a magnetic card reader and a receiving means for receiving data from the remote access device. Claim 25 also defines a network for communicating user identification data to a remote location. Applicant respectfully submits that these additional limitations further distinguish claim 25 over the prior art of record.

In addition to the foregoing distinctions, which define independent claims 21 and 25 over the prior art of record, Applicant now addresses the rejection of dependent claim 24. The Office Action rejected claim 24 as being unpatentable over Tait *et al.* in view of Waraksa *et al.* as applied to claim 21,

in further view of Wollenberg. Wollenberg is an article from the online publication of The Augusta Chronicle, which article was published on February 19, 1997.

Applicant respectfully submits that, as a matter of law, Wollenberg does not constitute prior art that can be used as a proper basis for rejecting claim 24. In this regard, Wollenberg is a publication that was retrieved from the Internet, and has a publication date of February 19, 1997. The present application, however, claims the benefit of U.S. provisional patent application Serial No. 60/040,316, which was filed on February 14, 1997. Therefore, the filing date of the present application predates the publication date of Wollenberg. As a result, Wollenberg does not constitute prior art to the present application, and therefore cannot properly be used to reject claims herein.

This result is not affected by statements made within the article itself. First of all, any such internal statements cannot be used to properly support a claim rejection. Specifically, and from an evidentiary standpoint, such statements amount to hearsay, and cannot be used as proof that, in fact, such a system was in public use as of that date. To better illustrate this point, simply consider the alternative. A company could simply monitor the patent portfolio of a competitor. After noting the issuance of a significant patent, the company could simply publish an article, a statement, a press release, etc., stating that they have been in possession of a product or system, of the type covered by the patent. The company (or any third party) could then request re-examination of the patent on the basis of the statements made in the later-published article. Although this example presumes wrong-doing on the part of the company (assuming the published statements were false), the U.S. Patent Laws regarding prior art are crafted to avoid the harsh results that may otherwise result from such wrong-doing.

Furthermore, and as it specifically relates to the Wollenberg article, the article expressly stated that “Mobile Corp. plans to introduce in May, an electronic gizmo that can be clipped to a key chain and uses radio signals that activate the gas pump . . .” Thus, even by admission within the article, the devices were not yet (as of the publication date) publicly available. Although the article noted that Mobile had been testing the devices since August 1996, there is no indication as to the confidentiality that may have been associated with the test group. If, in fact, the test group were to maintain the devices in confidentiality, then even the act of testing itself would not constitute prior, as the devices/actions would have been “suppressed” or “concealed” (See 35 U.S.C. § 102(g)). Nevertheless, the article itself does not constitute prior art, and the statements contained there cannot simply be presumed to be true.

Simply stated, the Wollenberg reference, as a matter of law, does not constitute prior art, and therefore should be removed from consideration. As a result, Applicant respectfully submits that claim 24 is in condition for allowance, independent of all other arguments advanced herein.

No Proper Suggestion or Motivation to Combine Tait *et al.* and Waraksa *et al.*

In addition to the foregoing substantive distinctions of independent claims 21 and 25 over the prior art of record, Applicant respectfully submits that the Office Action has failed to cite an appropriate suggestion or motivation to combine the teachings of Tait *et al.* and Waraksa *et al.* It has long been axiomatically stated that any new invention is simply a novel combination of known elements. Therefore, by definition, all elements within every patent claim are present within the prior art. In order for the prior art to render unpatentable (as obvious) a patent claim, it is well settled law

that there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..."Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create a remote access device for accessing a financial transaction machine as claimed by the Applicant.

The Office Action states that "it would have been obvious to one with ordinary skill in the art to [modify the teachings of Tait *et al.* with the teachings of Waraksa *et al.*] because transmission of a plurality of synchronization bits, a function code and an identification code was conventional in the art of remote access devices as evidenced by the disclosure of Waraksa *et al.*" (Office Action, p. 4, lines 6-10). As a matter of law, however, this fails to provide the requisite suggestion, teaching, or motivation

to selectively combine the independent teachings of Tait *et al.* and Waraksa *et al.* in the manner specifically claimed in independent claims 21 and 25. For example, why would a person possessing the system of Tait *et al.* be motivated to modify the communication parameters of the system to provide the synchronization bits and function code of Waraksa *et al.*? Why would a person possessing the passive (*i.e.*, buttonless) transmission system of Waraksa *et al.* desire to add buttons to the system, or to configure the transmitter to transmit track one or track two data? Without the benefit of hindsight, such a motivation is simply not present within the prior art.

To better illustrate the foregoing concepts, Applicant refers to *Continental Can Co., USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In that case, the claimed invention was directed to a ribbed bottom structure for reinforcing a plastic container. The patent in suit claimed that each container rib was hollow. The prior art consisted of several patents directed to ribbed configurations comprising the support structure of plastic container bottoms. The primary reference was a Marcus patent, which disclosed a plastic container having a ribbed bottom, wherein the ribs were solid. A Pentaloid patent was a secondary reference which, when inverted, closely resembled the claimed invention. The Federal Circuit, however, quickly dismissed this simple modification as constituting an obvious change by stating "Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down." *Continental Can* at 1270.

Several prior art references in the *Continental Can* case disclosed plastic containers having ribbed bottoms, wherein the ribs were hollow. In rejecting the notion that elements from prior art references can be mixed and matched randomly in an effort to render obvious the claimed invention,

the Federal Circuit stated that "When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Continental Can* at 1271. "The criterion of 35 U.S.C. § 103 is not whether the differences from the prior art are simple enhancements, but whether it would have been obvious to make the claimed structure. *Continental Can* at 1273.

For at least this separate and independent reason, Applicant respectfully submits that the rejections of independent claims 21 and 25, and therefore dependent claims 22-24 are misplaced, and should be removed.

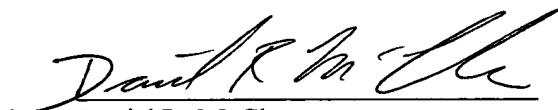
Again, Applicant respectfully submits that it is not the Applicant's burden to prove that no teaching, suggestion, or motivation exists within the prior art that would lead one of ordinary skill to make the particular combination of elements, as claimed. Instead, the initial burden is upon the Patent Office to establish a *prima facie* case of obviousness. Such a *prima facie* showing includes an identification of a proper suggestion or motivation within the prior art to make the combination. Nevertheless, Applicant has closely reviewed the references applied by the Office action and has been unable to identify any suggestion, motivation, or other teaching contained within these references or elsewhere in the prior art that would lead one of ordinary skill in the art (without the benefit of hindsight) to make the combination (both structure and function) as set forth in the claims of the present application. Therefore, if the Patent Office intends to maintain the obviousness rejections, based upon a combination of prior art references, the Applicant respectfully requests that the Patent Office identify the specific teachings within the prior art that would suggest the desirability or motivation for the particular combination of elements as claimed.

CONCLUSION

For at least the foregoing reasons, Applicant respectfully submits that all claims 21-25 are in proper condition for allowance, and respectfully request that the Examiner pass this case to issuance. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this Amendment and Response to Office Action. Any deficiency or additional fees that may be required are hereby authorized to be charged to our Deposit Account No. 20-0778.

Respectfully submitted,



Daniel R. McClure
Daniel R. McClure
Registration No. 38,962

THOMAS, KAYDEN, HORSTEMEYER & RISLEY L.L.P.
Suite 1500
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500